



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,131	01/14/2004	Mototaka Iwata	MIZ46.CON	3815
6980	7590	05/05/2005	EXAMINER	
TROUTMAN SANDERS LLP BANK OF AMERICA PLAZA, SUITE 5200 600 PEACHTREE STREET, NE ATLANTA, GA 30308-2216			BLAU, STEPHEN LUTHER	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,131

Applicant(s)

OSAKA

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

1. The request filed on 11 April 2005 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/757,131 is acceptable and a RCE has been established. An action on the RCE follows.

Double Patenting

2. Applicant is advised that should claim 22 be found allowable, claim 27 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmidt.

Schmidt discloses a projected wall portion offset from a face portion and extending upward from a sole portion and having a length along an axis toe to heel that is less than a length of a cavity portion along an axis in the form of slots ending the length of the wall and the surface with the reference number 81 located in figure 17 is a single wall (Fig. 17), a groove extending along a face portion provided on a surface on a single cavity portion side of a sole portion (Fig. 2), and a projected wall portion extending rearwardly beyond a top edge portion of a head (Fig. 2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stites (6,695,937) in view of Kosmatka (GB 2,331,249).

Stites discloses a head consisting of a single projected wall portion offset from a face portion and extending upward from a sole portion (Fig. 3) and having a length along an axis toe to heel that is less than a length of a cavity portion along an axis (Fig. 2), a groove extending along a face portion being provided on a surface on a cavity portion side of a sole portion (Fig. 3) and wall portion rising along a face portion toward a top edge portion (Fig. 2).

Stites lacks a thickness of a ball hitting portion in a face portion being made greater than a thickness of a top edge side portion of a face portion located between a ball hitting portion and a top edge portion and at least as thick as a thickness of a sole side portion of a face portion that is located between a ball hitting portion and a sole portion and that extends along a groove, a thickness of a ball hitting portion being made greater than a thickness of a toe side portion of a face portion located between a toe portion of a head portion and a ball hitting portion and greater than a thickness of a heel side portion of a face portion located between a heel portion of a head portion and a ball hitting portion, a thickness of a first region as defined by the claims being smaller than a thickness of a second region defined by the claims, and a thickness of a third region as defined by the claims being smaller than a thickness of a fourth region as defined by the claims.

Kosmatka discloses a thickness of a ball hitting portion in a face portion being made greater than a thickness of a top edge side portion of a face portion located between a ball hitting portion and a top edge portion and at least as thick as a thickness of a sole side portion of a face portion that is located between a ball hitting portion and a sole portion and that extends along a groove in the form of a head being able to hit a ball low on a face (Fig. 1D), a thickness of a ball hitting portion being made greater than a thickness of a toe side portion of a face portion located between a toe portion of a head portion and a ball hitting portion and greater than a thickness of a heel side portion of a face portion located between a heel portion of a head portion and a ball hitting portion (Figs. 1B, 1C, 1E), and a thickness of a first region as defined by the claims being smaller than a thickness of a second region defined by the claims, and a thickness of a third region as defined by the claims being smaller than a thickness of a fourth region as defined

Art Unit: 3711

by the claims (Fig. 1B) in order to design a rear face assigning thickness to each area of the face according to a magnitude of internal stress expected to be experienced by each area when a force due to striking a ball by a club front face is experienced and assigning a greater thickness in areas where the stress is greater and lesser thickness where the stress is lesser (Abstract). In view of the publication of Kosmatka it would have been obvious to modify the head of Stites to have a thickness of a ball hitting portion in a face portion being made greater than a thickness of a top edge side portion of a face portion located between a ball hitting portion and a top edge portion and at least as thick as a thickness of a sole side portion of a face portion that is located between a ball hitting portion and a sole portion and that extends along a groove, a thickness of a ball hitting portion being made greater than a thickness of a toe side portion of a face portion located between a toe portion of a head portion and a ball hitting portion and greater than a thickness of a heel side portion of a face portion located between a heel portion of a head portion and a ball hitting portion, a thickness of a first region as defined by the claims being smaller than a thickness of a second region defined by the claims, and a thickness of a third region as defined by the claims being smaller than a thickness of a fourth region as defined by the claims in order to design a rear face assigning thickness to each area of the face according to a magnitude of internal stress expected to be experienced by each area when a force due to striking a ball by a club front face is experienced and assigning a greater thickness in areas where the stress is greater and lesser thickness where the stress is lesser.

Art Unit: 3711

7. Claims 22 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stites (6,695,937) in view of Kosmatka (2,331,249) as applied to claims 18-21 above, and further in view Stites (6,077,173).

Stites (6,695,937) lacks a projected wall portion being trapezoidal in shape. Stites (6,077,173) discloses bridge members extending from a sole of a head (Figs. 13) being trapezoidal in shape (Col. 9, Lns. 37-43). In view of Stites (6,077,173) it would have been obvious to modify the head of Stites (6,695,937) to have a projected wall portion being trapezoidal in shape in order to utilize another design used in the market place of placing weight at a rear of a head and in order to distribute more weight lengthwise along a cantilever mass to distribute its effect more lengthwise.

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stites (6,695,937) in view of Kosmatka (2,331,249) as applied to claims 18-21 above, and further in view of admitted art (Official Notice).

Due to a lack of an argument, it is admitted that it is well known to form golf club heads by forging.

9. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt (5,330,187) in view of Kosmatka (GB 2,331,249).

Schmidt lacks a thickness of a ball hitting portion in a face portion being made greater than a thickness of a top edge side portion of a face portion located between a ball hitting portion

Art Unit: 3711

and a top edge portion and at least as thick as a thickness of a sole side portion of a face portion that is located between a ball hitting portion and a sole portion and that extends along a groove.

Kosmatka discloses a thickness of a ball hitting portion in a face portion being made greater than a thickness of a top edge side portion of a face portion located between a ball hitting portion and a top edge portion and at least as thick as a thickness of a sole side portion of a face portion that is located between a ball hitting portion and a sole portion and that extends along a groove in the form of a head being able to hit a ball low on a face (Fig. 1D) in order to design a rear face assigning thickness to each area of the face according to a magnitude of internal stress expected to be experienced by each area when a force due to striking a ball by a club front face is experienced and assigning a greater thickness in areas where the stress is greater and lesser thickness where the stress is lesser (Abstract). In view of the publication of Kosmatka it would have been obvious to modify the head of Schmidt to have a thickness of a ball hitting portion in a face portion being made greater than a thickness of a top edge side portion of a face portion located between a ball hitting portion and a top edge portion and at least as thick as a thickness of a sole side portion of a face portion that is located between a ball hitting portion and a sole portion and that extends along a groove in order to design a rear face assigning thickness to each area of the face according to a magnitude of internal stress expected to be experienced by each area when a force due to striking a ball by a club front face is experienced and assigning a greater thickness in areas where the stress is greater and lesser thickness where the stress is lesser.

Response to Arguments

10. Applicant's arguments with respect to claims 18-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 29 April 2005


STEPHEN BLAU
PRIMARY EXAMINER